

Application Number: 10/525,284
Amendment Dated: April 12, 2010
Office Action Dated: November 12, 2009

REMARKS

This amendment is responsive to the Office Action mailed November 12, 2009 for which a three (3) month period of response was given. A Petition and fee for a two (2) month extension of time accompany this paper. The Commissioner is hereby authorized to charge the necessary fee for the above-mentioned two month extension of time, and any other fee necessary in conjunction with the filing of this Reply, to Deposit Account No. 50-0959, Docket Number 089498.0441.

Claims 1, 4 through 8 and 21 remain pending in the present application. Accordingly, entry and consideration of the remarks which follow is believed due and is respectfully requested.

I. The 35 U.S.C. § 103(a) Rejection:

Claims 1, 4 through 9 and 21 have been rejected under 35 U.S.C. § 103(a) over Loo (United States Patent No. 5,373,077) in view of Buese et al. (United States Patent No. 5,347,028).

Turning to Loo, Loo discloses organosilicon crosslinked polymers and crosslinkable pre-polymers that are the reaction product of: (a) a cyclic polysiloxane in which each silicon atom is substituted with: (i) a saturated, substituted or unsubstituted alkyl or alkoxy group or a substituted or unsubstituted aryl or aryloxy group, and (ii) a substituted or unsubstituted hydrocarbon group having at least one carbon-carbon double bond that is reactive in hydrosilation; (b) at least one organosilicon compound having at least two Si-H groups; and optionally (c) a hydrocarbon polyene having at least two non-aromatic carbon-carbon double bonds that are reactive in hydrosilation. As is correctly pointed out by the Examiner, Loo does not disclose cyclosiloxanes where the number of repeating units contained therein is 5 or more.

Given the disclosure contained therein, it is clear that Loo does not disclose, teach or suggest a compound that utilizes two or more Si-H groups as crosslinking sites for a poly(cyclosiloxane) network. In this regard, the Examiner has failed to point out where Loo discloses, teaches or suggests a poly(cyclosiloxane) network that utilizes two or more

Application Number: 10/525,284
Amendment Dated: April 12, 2010
Office Action Dated: November 12, 2009

Si-H groups as crosslinking sites for such a poly(cyclosiloxane) network. All Loo discloses is that a crosslinked polysiloxane compound is yielded upon the combination of elements (a) through (b), and optionally (c) as discussed above. Thus, it is clear from Loo that both elements (a) through (b) are required (emphasis supplied). Therefore, the contention that it would be possible to achieve a crosslinked composition by the elimination of an element of Loo is clearly against the clear teachings of Loo and the examples contained therein. Given this, it would seem that the Examiner has ignored the obvious differences between the claimed invention and Loo. Instead, it would seem that the Examiner believes Loo inherently discloses the above claimed features. However, it is well settled:

[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (citing In re Oelrich, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Given the legal conclusions set forth in the cited cases, it is well settled that the missing function, or element, must necessarily result from the cited piece of art (emphasis supplied). Since Loo does not disclose, teach or suggest the claimed poly(cyclosiloxane) reaction product of pending claim 1, the present invention cannot be deemed obvious over Loo.

Regarding the secondary art Buese et al., the Examiner contends that Buese et al. discloses cyclosiloxanes having 3 to 8 Si-O repeating units it would have been obvious to combine Loo with Buese et al. to arrive at the presently claimed invention. Applicants respectfully disagree,

Application Number: 10/525,284
Amendment Dated: April 12, 2010
Office Action Dated: November 12, 2009

As previously stated, Buese et al. fails to cure the deficiencies of Loo. This is because, as can be seen from the disclosure contained at columns 5 and 6 of Buese et al, Buese et al. fails to disclose, teach or suggest any polycyclosiloxane the contains two or more Si-H groups in the cyclic portion of the polycyclosiloxanes disclosed therein. Thus, Buese et al. fails to disclose, teach or suggest a crosslinked network that is formed by forming crosslinks between two Si-H groups. As such, the combination of Buese et al. with Loo does not cure the inoperability of Loo since Loo still would require both of elements (a) and (b) to be present. As such, the Examiner has failed to make a *prima facie* case of obviousness over the combination of Loo and Buese et al.

Thus, for at least the above reasons, the combination of Loo and Buese et al. cannot render obvious claims 1, 4 through 8 and 21. Accordingly, the 35 U.S.C. § 103(a) rejection of claims 1, 4 through 8 and 21 is believed to be unfounded, and withdrawal thereof is believed due and is respectfully requested.

II. Conclusion:

Accordingly, reconsideration and withdrawal of the pending 35 U.S.C. § 103(a) rejection of claims 1, 4 through 8 and 21 is believed due and is respectfully requested.

For at least the foregoing reasons, the present application is believed to be in condition for allowance, and a Notice of Allowance is respectfully requested.

Should the Examiner wish to discuss any of the foregoing in more detail, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

/Joseph J. Crimaldi/
Joseph J. Crimaldi, Reg. No. 41,690
Roetzel & Andress
222 S. Main St.
Akron, Ohio 44308
(330) 376-2700

April 12, 2010